



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/809,367	03/15/2001	Edward J. Hogan	AP33088-070457.0985	5526

7590 12/22/2010
BAKER BOTTS L.L.P.
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112-0228

EXAMINER

WINTER, JOHN M

ART UNIT	PAPER NUMBER
----------	--------------

3685

MAIL DATE	DELIVERY MODE
-----------	---------------

12/22/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/809,367	Applicant(s) HOGAN ET AL.	
	Examiner JOHN M. WINTER	Art Unit 3685	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 October 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Acknowledgements

1. The Applicants amendment filed on October 6, 2010 is hereby acknowledged, Claims 1-10 remain pending.

Response to Arguments

2. The Applicant states that the prior art fails to disclose "using an issuer computer to provide secure payment software comprising said second payment number to a purchaser computer." and "a second financial account number that is reusable by the purchaser for any purchase in which said first payment account number could be used and which does not have use-triggered restrictions"

The Examiner responds that Walker discloses "The single-use credit card number is preferably a 16-digit number that can be recognized as a conventional credit card number." (Column 6, lines 30-38) The Examiner submits that Walker teaches secondary card that is usable in any context the primary card is usable and therefore meets that claimed limitation.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-10 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not

Art Unit: 3685

described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention..

Claims 1 and 4 recite the feature “said second account number further not having use triggered restrictions and not being a transaction number and having an encryption key assigned thereto”; however, there is no corresponding language in the Specification to support the claimed feature of “not having use triggered restrictions”. Paragraph 20 of the Specification indicates that the second account number is linked to the first and had all of the same restrictions as the first.

Claims 2-3 and 5-10 are dependant upon claim 1 or contain similar limitations and are rejected for at least the same reasons.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al., (U.S. Patent No. 6,163,771) in view of Fleming (US Patent 5,953,710) and further in view of Flitcroft et al., (U.S. Patent No. 6,636,833).

As per claims 1 and 4,

Art Unit: 3685

6. Walker et al.('771)discloses a method of conducting a transaction by a purchaser over a communications network, comprising:

assigning to said purchaser a first payment account number having a status which changes over time, by an assigning computer; (figures 7 and 13; column 7, lines 20-26)

providing a second payment account number associated with said first payment account number to a purchaser computer by an issuer computer, said second payment account number being reusable by the purchaser for any purchase in which said first payment account number could be used, (figures 3B, 9A, and 10-11B; Column 6, lines 29-52, column 7, lines 20-26 – Examiner notes that “being reusable by the purchaser for any purchase in which said first payment account number could be used” is directed towards non-functional descriptive material and as such does not serve as a limitation on the claim. In other words language that is not functionally interrelated with useful acts, structure, or properties of the claimed invention will not serve as a limitation. See in re Gulak, 217 USPQ 401 (CAFC 1983), ex parte Carver, 227 USPQ 465 (BdPatApp& Int 1985) and in re Lowry, 32 USPQ2d 1031 (CAFC 1994)

said second account number further not having use triggered restrictions and not being a transaction number and having an encryption key assigned thereto (figures 6 and 7; column 6, lines 30-53; – Examiner notes that “said second account number further not having use triggered restrictions and not being a transaction number and having an encryption key assigned thereto” is directed towards non-functional descriptive material and as such does not serve as a limitation on the claim. In other words language that is

Art Unit: 3685

not functionally interrelated with useful acts, structure, or properties of the claimed invention will not serve as a limitation. See *in re Gulak*, 217 USPQ 401 (CAFC 1983), *ex parte Carver*, 227 USPQ 465 (BdPatApp& Int 1985) and *in re Lowry*, 32 USPQ2d 1031 (CAFC 1994))

wherein providing said second payment account number comprises:

receiving identification information from a purchaser computer

at an issuer computer ; verifying said identification information by an issuer computer,

After verifying said identification information providing secure payment software

comprising said second payment number to a purchaser computer by an issuer computer;

(figures 3B, 9A, and 10-11B; column 7, lines 20-26)

Walker et al. do not explicitly recite sending data from a purchaser computer by said

secure payment software to a merchant computer comprising: at least one of said second

payment account number and a digital certificate that includes said second payment

account number, the cardholder's card expiration date, the merchant identification

number, and at least one of a generated message authentication code (MAC) and a digital

signature generated by the secure payment application; receiving a request for

authorization for payment of said transaction with said second payment account number

and not said first payment account number at an issuer computer; identifying said

purchaser's first payment account number in response to said authorization request by an

acquirer computer or an issuer computer programmed to discriminate between said

second payment account number and said first payment account number with at least one

translation key that can be used to translate between the second payment account number

and first payment account number; Fleming ('710) discloses sending data from a purchaser computer by said secure payment software to a merchant computer comprising: at least one of said second payment account number and a digital certificate that includes said second payment account number, the cardholder's card expiration date, the merchant identification number, and at least one of a generated message authentication code (MAC) and a digital signature generated by the secure payment application;(Figure 6 and 7, column 6, lines 20-48, column 10, lines 12-31) identifying said purchaser's first payment account number in response to said authorization request by an acquirer computer or an issuer computer programmed to discriminate between said second payment account number and said first payment account number with at least one translation key that can be used to translate between the second payment account number and first payment account number; (Figure 7, Column 7, lines 10-24, column 8, lines 17-40, Column 10, lines 12-27). responding to said authorization request based upon said status of said first payment account number at the time of the transaction by acquirer computer or an issuer computer programmed to discriminate between said second payment account number and said first payment account number.(Column 9, lines 25-47) Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Walker et al. ('771, figure 13) with Fleming ('710)in order to create a more flexible system by allowing users to use proxy card numbers for multiple transactions and obtain additional lists of numbers.

Walker et al. do not specifically recite receiving a request for authorization for payment of said transaction with said second payment account number and not said first payment

Art Unit: 3685

account number at an issuer computer; Filcroft et al. teaches receiving a request for authorization for payment of said transaction with said second payment account number and not said first payment account number at an issuer computer;(Column 23, lines 15-29, Column 25, lines 12-33) It would have been obvious to one of ordinary skill to combine the teachings of Walker et al. ('771) in view of Fleming ('710), with Flitcroft et al. in order to create a more flexible system by allowing users to use proxy card numbers for multiple transactions.

7. In regard to claim 4, Walker et al. ('771) discloses recognizing said pseudo account number and cryptographically processing said pseudo account number to produce said first payment account number using an acquirer computer or an issuer computer; (Column 6, lines 39-54).

8. As per claim 2.

Walker et al.('771) discloses the method of Claim 1, wherein said authorization request includes a cryptographic code based on said encryption key, and wherein said response to said authorization request is further based on said cryptographic code.(Column 6, line 54- column 7, line 8)

9. As per claim 3.

10. Walker et al.('771) discloses the method of Claim 2, wherein said status is a function of the credit balance available for use by said purchaser, which credit balance changes over time as a result of the purchases made by the

purchaser.(Column 7, lines 20-27, Column 12 ,lines 9-17)

11. As per claim 5.

Walker et al.(‘771) The method of Claim 4,
wherein said pseudo account number is indicated
to be different from said first payment account number by a special identifier within the
pseudo account number. (column 7, lines 37-44)

12. As per claim 6.

Walker et al.(‘771) The method of Claim 4,
wherein said pseudo account number is indicated to be such by data within a transaction
record. (column 7, lines 20-44)

13. As per claim 7.

Walker et al.(‘771) discloses the method of Claim 4,
wherein said cryptographic key is a secret key.(Column 6, lines 61- column 7, line 10)

14. As per claims 9-10.

Walker et al.(‘771) discloses the method of Claim 4,
wherein said pseudo account number is obtained by encrypting the associated first
payment account number utilizing DESX methodology and wherein said pseudo account
number is converted back into its associated first payment account number utilizing DEA

Art Unit: 3685

with a double-length key.(Column 9, lines 10-30 – Examiner notes that DESX and DEA encryption techniques are old and well know in the field of art and thus is no more than the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for improvement. Ex parte Smith, 83 USPQ2d 1509 (Bd. Pat. App. & Int.)

15. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al., U.S. Patent No. 6,163,771 and Flitcroft et al., U.S. Patent No. 6,636,833 as applied to 4, and in further view of Lee et al., U.S. Patent No. 6,018,717.

As per claim 8, Walker et al. teach a message authentication code that comprises a digital signature generated by a secure payment application (column 8, lines 9-36). However, Walker et al. do not specifically recite public key certificates. Lee et al. teach a method for performing secure transactions using card unique certificates that are associated with a public key of a private/public key pair (column/line 11/15-12/18). Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Walker et al. and Lee et al. in order to uniquely associate a transaction message with a user ('717, column/line 10/38-11/13) and to, in the event the private key ('771, abstract) is obtained by a malicious user, to provide protection against fraud by using different keys to encrypt and decrypt a transaction message ('717, column/line 10/38-11/13).

Double Patenting

16. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-10 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-6 of U.S. Patent No. 7,177,848. Although the conflicting claims are not identical, they are not patentably distinct from each other because the same process is substantially disclosed.

Conclusion

Applicant is reminded that functional recitation(s) using the word “for” or other functional language have been considered but given less patentable weight because they fail to add any steps and are thereby regarded as intended use language. A recitation of the intended use of the claimed invention must result in additional steps. See *Bristol-Myers Squibb Co. v. Ben Venue Laboratories, Inc.*, 246 F.3d 1368, 1375-76, 58 USPQ2d 1508, 1513 (Fed. Cir. 2001) (Where the language in a method claim states only a purpose and intended result, the expression does not result in a manipulative difference in the steps of the claim.).

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

Art Unit: 3685

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOHN M. WINTER whose telephone number is (571)272-6713. The examiner can normally be reached on M-F 8:30-6, 1st Fridays off. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Calvin Hewitt can be reached on (571) 272-6709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Application/Control Number: 09/809,367
Art Unit: 3685

Page 13

JMW

/Jalatee Worjloh/
Primary Examiner, Art Unit 3685